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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/726,963

12/03/2003

David Ernest Hartley

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4386

9896 7590 07/07/2010

COOK GROUP PATENT OFFICE

P.O. BOX 2269

BLOOMINGTON, IN 47402

EXAMINER

SEVERSON, RYAN J

ART UNIT

PAPER NUMBER

3731

MAIL DATE

DELIVERY MODE

07/07/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/726,963	Applicant(s) HARTLEY ET AL.	
	Examiner Ryan J. Severson	Art Unit 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6,7,9 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6,7,9 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/14/2010 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 6, 9 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brightbill (2003/0204245) in view of Cox et al. (5,824,040).**

Brightbill discloses a prosthesis comprising a graft-covered stent portion (120, see paragraph [0023]) comprising at least 3 stents (110) that are zig-zag shaped and self-expanding stainless steel or nitinol (see paragraph [0024]). The prosthesis also has an uncovered stent portion (140, see paragraph [0026]) being the same shape and material as the covered stents. However, Brightbill fails to disclose flexible links between the stents comprising threads or fibers.

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4. Attention is drawn to Cox et al., who teach it is known to connect stents together with threads or fibers (see figure 7E) to increase the flexibility of the prosthesis.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have replaced the weld links of Brightbill with the flexible thread links of Cox et al. to increase the flexibility of the Brightbill prosthesis.

5. Further regarding claim 24, the combination of Brightbill and Cox et al. does not disclose 8-10 uncovered stents. However, Examiner holds this is merely an obvious matter of design choice. A person having ordinary skill in the art would have recognized that the uncovered stent portion could be created with more than two uncovered stents to be able to increase the effective treatment length of the prosthesis. A person having ordinary skill in the art would have recognized that the number of uncovered stents in the prosthesis is not critical to the invention. Therefore, Examiner holds it would have been obvious to one having ordinary skill in the art at the time the invention was made to have created the prosthesis of Brightbill with 8-10 uncovered stents instead of two for the purpose of creating a longer prosthesis that is capable of treating a longer section of damaged vessel. See paragraphs 10 and 11 below for further explanation.

6. Regarding claim 6, the combination of Brightbill and Cox et al. does not disclose the knot holding the threads to the stents. However, Examiner asserts the use of a specific knot would have been obvious to one of ordinary skill in the art at the time the invention was made to secure the graft to the stent.

7. **Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brightbill (2003/0204245) in view of Cox et al. (5,824,040) as applied to claim 24 above, and further in view of McNamara et al. (6,004,347).** The combination of Brightbill and Cox et al. fails to disclose barbs extending from the stent through the graft. Attention is drawn to McNamara et al., who teach a graft disposed on the outside of a stent with a barb penetrating through the graft (see figures 10 and 11) to hold the graft onto the stent and to more securely anchor the stent against the vessel wall when deployed. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used barbs on the stents of the combination of Brightbill and Cox et al. in the manner taught by McNamara et al. to hold the graft onto the stent and to more securely anchor the stent against the vessel wall when deployed.

Response to Arguments

8. Applicant's arguments filed 6/14/2010 have been fully considered but they are not persuasive. Applicant argues there is no disclosure in Brightbill of the particular combination of a covered area and an uncovered area as claimed and no suggestion of the use of the device as a treatment device for aortic dissection.

9. In response to applicant's argument that Brightbill fails to disclose or suggest use of the device for treatment of aortic dissection, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Examiner holds that the device is capable of use in the claimed manner.

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10. Examiner also asserts that having the claimed number of uncovered stents (i.e. 8-10) is an obvious matter of design choice. One having ordinary skill in the art would recognize that the length of the total prosthesis (and thereby, by extension, the number of uncovered stents) is obvious and a function of the intended use of the prosthesis. Examiner holds that evidence for this notion exists within Brightbill when comparing figures 1 and 4. Figure 1 shows only two uncovered stents, and figure 4 shows six uncovered stents. Therefore, it is clear that the specific number of uncovered stents in the prosthesis of Brightbill is not critical to the invention. The criticality lies in the concept that the prosthesis has both covered and uncovered stent portions.

11. Further, Examiner notes that applicant has not shown a criticality of the claimed range (i.e. 8-10 stents). Absent specific criticality, Examiner will maintain his position that one of ordinary skill in the art would have recognized that the prosthesis of Brightbill could be created with 8-10 uncovered stents instead of just two. An example motivation for doing so would be so that the prosthesis could be used to treat a much longer length of damaged blood vessel.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan J. Severson whose telephone number is (571) 272-3142. The examiner can normally be reached on Monday - Friday 8:30-5:00.

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13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ryan J Severson/
Examiner, Art Unit 3731
7/5/10